

**REMARKS**

Claims 1-34 are pending. Claims 1, 4, 5, 8, 9, 12, 13, 16, 18, 19, 21, 23-25, 26, 28, 30, 31, 33, and 34 have been amended. Claims 1-34 remain in the application. No new matter has been entered.

5            Claims 1-5, 8-13, 16, 17, 33, and 34 again stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,692,206, issued to Shirley et al. ("Shirley"), in view of U.S. Patent No. 5,774,866, issued to Horowitz et al. ("Horowitz"). Applicant traverses the rejection.

10            To establish a *prima facie* case of obviousness, the examiner has the burden of proving that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) there is a reasonable expectation of success; and (3) the combined references teach or suggest all the claim limitations. MPEP § 2143. A *prima facie* of  
15            obviousness case has not been shown.

             The Shirley patent discloses a contract generation system, which provides standard contracts that can be customized with alternative, supplemental, and additional provisions (Col. 2, lines 11-14). The standard contract documents comprise at least one standard contract having a plurality of standard provisions  
20            (Col. 2, lines 42-44). Existing contract folders, standard contract documents, and provision libraries are preferably contained on mass storage devices of a personal computer (Col. 6, lines 26-29). The provision libraries comprise a shared provision library and contract-type provision libraries (Col. 5, lines 14-16). The shared provision library comprises standard provisions and user defined  
25            provisions; the standard provisions comprise alternate provisions, supplemental provisions, and additional provisions (Col. 5, lines 22-30).

             The Horwitz patent discloses systems and methods to check relationship problems in an organization (Col. 3, lines 19-21). Existing relationship data denotes parties having existing relationships within the organization, and  
30            associations between existing parties and persons within the organization (Col. 3,

lines 24-28). For example, in a law firm, the association data may denote attorneys responsible for the matters being handled on behalf of existing clients (Col. 3, lines 28-31). Proposed relationship data denotes parties associated with proposed matters (Col. 3, lines 32-34). The proposed relationship data and the existing relationship data are compared and a potential matter is identified as having a match when a proposed party associated with a proposed matter matches an existing party (Col. 3, lines 35-40). The existing and proposed parties match if relationship data designating the proposed party and the existing party correspond to a pre-selected degree of correspondence (Col. 3, lines 43-47). Once a match is found, the party relationship and type data for the matching parties is retrieved and compared to determine whether a potential conflict exists (Col. 18, lines 62-67). A potential problem signal incorporating information about the match is automatically sent to an evaluator (Col. 3, lines 50-52 and 59-62). For example, in a law firm, the attorneys responsible for the affairs of an existing client will be informed of potential conflicts relating to that existing client (Col. 4, lines 10-12).

First, there is no suggestion or motivation to modify or combine the references. Shirley teaches a contract authoring system responsive to requests from a user to manage the creation of a contract document (Col. 2, lines 24-28). Horwitz teaches checking for conflicts, termed “relationship problems,” for proposed new matters in an organization that deals with numerous clients, such as a law firm (Abstract; Col. 2, line 61-Col. 3, line 10). Certainly, a connection can be drawn between contract generation and conflict resolution. In law, for instance, an attorney cannot undertake to draft a contract for parties who are on opposite sides of the “deal” without first ensuring that any conflicts of interest between the simultaneously-represented parties have been disclosed and properly waived. However, generating a contract in itself does not require first checking for conflicts of interest and can be performed in the abstract without involving particular parties. Thus, the contract generation system taught by Shirley presupposes that no conflicts of interest or other relationship problems exist and leaves the question of relationship problems, as well as other ancillary issues,

open. In contrast, the conflict resolution system taught by Horwitz focuses on ensuring that the relationship between an organization and its clients are free of relationship problems.

One of ordinary skill in the art might be inclined to check for relationship  
5 problems as part of contract generation, but the two problems are separate and  
distinct. Relationship problems concern the relationships between the contracting  
*parties* and the contract *writer*, whereas contract generation addresses crafting  
language to memorialize an *agreement* between those parties. In other words,  
contracts are written independently from the identify of the contract writer and  
10 any relationship he or she may share with the contracting parties. A similar  
inclination might be found to perform fingerprint checking on the parties as part  
of contract generation to confirm their identities, or to verify the credentials of the  
contract writer to substantiate his or her qualifications to write the contract.  
Ancillary activities, such as resolving relationship problems, checking  
15 fingerprints, or verifying credentials are not germane to the task of generating a  
contract, and Shirley fails to suggest or provide a motivation to resolve  
relationship problems. Therefore, except to add complimentary yet separate and  
distinct functionality, there is no suggestion or motivation to modify or combine  
the Shirley and Horwitz references.

20 Arguably, a reasonable expectation of success exists. Combining  
Horwitz's teachings would add relationship problem checking and clearance into  
the automated contract authoring system taught by Shirley, even though the  
contract authoring system does not require, and can operate wholly independently  
from, relationship problem checking and clearance.

25 Nevertheless, the combined references fail to teach or suggest all the claim  
limitations. Shirley teaches automating legal document generation with the  
objects of providing more flexibility in defining the terms of a particular contract,  
allowing for the negotiation of contract terms with another party, and providing  
the operator with sufficient flexibility to be useful in a greater variety of situations  
30 (Col. 1, line 66-Col. 2, line 61). Horwitz teaches checking for and clearing

relationship problems (Col. 3, lines 13-17; Col. 25, lines 44-52). Combining the teachings of Shirley and Horwitz provides for comparing proposed and existing relationship data to identify relationship problems in a potential matter that involves generating a contract between a proposed and existing party.

5           Independent Claims 1, 9, 33, and 34 have been amended to clarify the inventive subject matter and better distinguish over Shirley and Horwitz. For instance, independent Claim 1 recites “a list of clause preferences stored into the database to specify content *and structure* of the complex document for the third party” and further recites “an individual clause comparison module comparing the  
10 individual clause against the clause preferences list for the at least one third party and including *and structuring* the conditions affecting the at least one third party provided in the provisions and terms of the individual clause in the complex document” (emphasis added). Independent Claim 9 recites “storing a list of clause preferences into the database to specify content *and structure* of the  
15 complex document for the third party” and further recites “comparing the individual clause against the clause preferences list for the at least one third party and including *and structuring* the conditions affecting the at least one third party provided in the provisions and terms of the individual clause in the complex document” (emphasis added). Independent Claim 33 recites “a list of clause  
20 preferences to specify content *and structure* of the complex document for the third party” and further recites “a clause preference comparison module comparing the contract clause and the contract outline against the clause preferences list for the at least one third party and including *and structuring* the conditions affecting the at least one third party provided in the provisions and  
25 terms of the contract clause and the organizational framework of the contract outline in the complex document” (emphasis added). Independent Claim 34 recites “storing a list of clause preferences to specify content *and structure* of the complex document for the third party” and further recites “comparing the contract clause and the contract outline against the clause preferences list for the at least  
30 one third party and including *and structuring* the conditions affecting the at least

one third party provided in the provisions and terms of the contract clause and the organizational framework of the contract outline in the complex document” (emphasis added). Support can be found in the specification on page 8, lines 19-24; page 9, lines 17-28; and page 10, lines 15-21.

5           In contrast, Horwitz teaches tracking data relating to both existing and potential matters in a central matter table and an assigned persons table keyed to a table of assigned person roles, which include “billing,” “responsible,” and “other” (Col. 10, lines 37-40, 47-49, and 52-62). The data structure taught by Horwitz makes possible retrieving data relating to the *role* of persons assigned to a  
10   particular matter (Col. 10, lines 62-Col. 11, line 14). The Shirley-Horwitz combination fails to teach or suggest specifying structure of a complex document and structuring conditions provided in contract clauses that affect the parties, per Independent Claims 1, 9, 33, and 34. Thus, the combined references fail to teach or suggest all the claim limitations.

15           Accordingly, a *prima facie* case of obviousness has not been shown for Independent Claims 1, 9, 33, and 34. Claims 2-5 and 8 are dependent upon Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. Claims 10-13, 16, and 17 are dependent upon Claim 9 and are patentable for the above-stated reasons, and as further distinguished by the  
20   limitations therein. Withdrawal of rejection under 35 U.S.C. § 103(a) is respectfully requested.

          Claims 6, 7, 14, and 15 again stand rejected under 35 U.S.C. § 103(a) as being obvious over Shirley and Horowitz, in view of U.S. Patent No. 5,553,216, issued to Yoshioka et al. (“Yoshioka”). Applicant traverses the rejection.

25           Claims 6 and 7 are dependent upon Claim 1 and are patentable for the above-stated reasons with respect to the first obviousness rejection, and as further distinguished by the limitations therein. Claims 14 and 15 are dependent upon Claim 9 and are patentable for the above-stated reasons with respect to the first obviousness rejection, and as further distinguished by the limitations therein.  
30   Withdrawal of rejection under 35 U.S.C. § 103(a) is respectfully requested.

Claims 18, 19, 21, 22, 24-26, 28, 29, 31 and 32 again stand rejected under 35 U.S.C. § 103(a) as being obvious over Shirley, in view of Horowitz, and further in view of U.S. Patent No. 6,202,066, issued to Barkley et al. (“Barkley”).

Applicant traverses the rejection. A *prima facie* of obviousness case has not been  
5 shown.

Barkley discloses a role/group permission association using object access type that associate roles with permissions and roles with a set of objects, such as resources or files (Abstract; Col. 4, lines 53-66). The same users can be given the same permissions provided with respect to an additional object by adding that  
10 role, assigned to those users, to the corresponding object (Col. 4, line 66-Col. 5, line 4).

Independent Claims 18 and 25 have been amended to clarify the inventive subject matter and better distinguish over Shirley, Horwitz, and Barkley. For instance, independent Claim 17 recites “a table of clauses for use in a legal  
15 document compiled into a shareable database, each clause relating to conditions affecting one or more individual third parties and including user authorizations to control user access and clause preferences to specify content *and structure* provisions and terms for a specific subject matter” and further recites “a clause panel authenticating the clause selection against the user authorizations for the  
20 user and specifying content *and structure* from the clause preferences for the at least one third party and displaying the clause following successful authentication” (emphasis added). Independent Claim 25 recites “compiling a table of clauses for use in a legal document into a shareable database, each clause relating to conditions affecting one or more individual third parties and including  
25 user authorizations to control user access and clause preferences to specify content *and structure* provisions and terms for a specific subject matter” and further recites “authenticating the clause selection against the user authorizations for the user and specifying content *and structure* from the clause preferences for the at least one third party” (emphasis added). Support can be found in the  
30 specification on page 8, lines 19-24; page 9, lines 17-28; and page 10, lines 15-21.

In contrast, Horwitz teaches tracking data relating to both existing and potential matters in a central matter table and an assigned persons table keyed to a table of assigned person roles, which include “billing,” “responsible,” and “other” (Col. 10, lines 37-40, 47-49, and 52-62). The data structure taught by Horwitz makes possible retrieving data relating to the *role* of persons assigned to a particular matter (Col. 10, lines 62-Col. 11, line 14), to which Barkley adds permissions. The Shirley-Horwitz-Barkley combination fails to teach or suggest specifying structure of a complex document and structuring conditions provided in contract clauses that affect the parties, per Independent Claims 18 and 25.

Thus, the combined references fail to teach or suggest all the claim limitations.

Accordingly, a *prima facie* case of obviousness has not been shown for independent Claims 18, and 25. Claims 19, 21, 22, and 24 are dependent upon Claim 18 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. Claims 26, 28, 29, 31, and 32 are dependent upon Claim 25 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. Withdrawal of rejection under 35 U.S.C. § 103(a) is respectfully requested.

Claims 20, 23, 27, and 30 again stand rejected under 35 U.S.C. § 103(a) as being obvious over Shirley, Horowitz, and Barkley, in view of Yoshioka.

Applicant traverses the rejection.

Claims 20 and 23 are dependent upon Claim 18 and are patentable for the above-stated reasons with respect to the third obviousness rejection, and as further distinguished by the limitations therein. Claims 27 and 30 are dependent upon Claim 25 and are patentable for the above-stated reasons with respect to the third obviousness rejection, and as further distinguished by the limitations therein. Withdrawal of rejection under 35 U.S.C. § 103(a) is respectfully requested.

The prior art made of record and not relied upon has been reviewed by the applicant and is considered to be no more pertinent than the prior art references already applied.

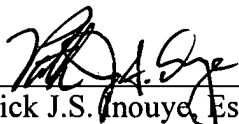
Claims 1-34 are believed to be in a condition for allowance. Entry of the foregoing amendments is requested. Reconsideration of the claims, withdrawal of the finality of the Office action and a Notice of Allowance are earnestly solicited.

Please contact the undersigned at (206) 381-3900 regarding any questions or  
5 concerns associated with the present matter.

Respectfully submitted,

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Dated: February 23, 2006

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